

Remarks/Arguments

In his August 31, 2005 Office Action, the examiner has made numerous rejections. Some based on 35 U.S.C. § 112 ¶'s 1 and 2. Others based on 35 U.S.C. §§ 102 and 103.

With respect to the § 112 ¶ 1 rejections, the examiner contends that the limitations of an article having (i) a “consistently repeated pore configuration,” and (ii) groups of larger and smaller pores which have “first and second size ranges being identifiably distinct” in claim 19, and similar limitations in claim 32 are not supported, and thus fail to satisfy the written description requirement. These features, however, were disclosed in the figures and written description of the original filing. See e.g., originally filed FIGs. 2 and 4 as well as the original specification. FIG. 2 shows internodal relationships (including distinct pore size groupings) which repeat themselves. For demonstrative purposes, we have added some helpful markings to the figure which show that the pore configurations are consistently repeated and that two pore groups are created which have sizes which are identifiably distinct. Referring to attached FIG. 2, we see that a pattern of long fibrils creating large pores between the first and second elongated nodes 5 (circled on the figure) create one group of discretely sized pores which are larger than a second group of smaller pores 6 created between shorter fibrils 7. A small “third” node 8 is interposed between the first and second nodes. These features are all included in what is referred to as the internodal arrangement. On both the right and left in the figure, it may be seen that this arrangement is repeated between the fourth and fifth nodes. Thus, there is support for the repeated arrangement now claimed.

With respect to the examiner's claim 19 assertions that the identifiably distinct pore groups were not disclosed in the original filing, support for these recitations may be found

on Page 2 from lines 15-16 and line 35 through line 7 on Page 3. Also on Page 3 at lines 24-38. Further details regarding how the product is produced are disclosed from line 12 on Page 6 through line 8 on Page 7.

The Examiner also makes § 112 ¶ 1 written description rejections with respect to claim 32 suggesting that the limitations of a “regularly repeated pore configuration” and “second plurality of pores being discrete from and smaller than said first plurality of pores” were not supported in the original disclosure. These limitations are substantially similar to the claim 1 limitations discussed immediately above, and are supported in the same manner.

The Examiner also makes a § 112 ¶ 1 enablement rejection. In this rejection, the Examiner suggests that the limitations of “said configuration created by forming a mixture of a first resin and a second resin having a different expandability characteristic than said first resin” and a “first material mixed with a second material to comprise a compound, said second material being less expandable than said first material” are too broad and in excess of what is taught in the specification. The Examiner cites two cases in support of his rejections – *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976) and *Ex parte Slob*, 157 USPQ 172 (PO BdApp 1967).

Mayhew and *Slob* do not apply here. *Mayhew* involved the evaluation of a method claim. See 527 F.2d at 1231. Method claims, of course, are directed to a series of steps. The *Mayhew* applicant in its disclosures failed to describe how the process would work without a step which was necessarily included in all the examples provided. *Slob* also involved the evaluation of a method claim. The *Slob* claim, however, included strange indefinite recitations which described compounds in terms of what it was desired that they do rather than what they were.

Unlike the claims analyzed in these cases, the claims in this application are proper product by process claims. The patentability of product by process claims is determined based on the product itself, not the process. MPEP 2113.

Contrary to the assertions of the Examiner, the legal requirement of enablement does not require the specification to describe technological developments concerning the method by which the patented product is made where those developments are immaterial to the claim. *See e.g., Amgen, Inc. v. Hoechst Marion Roussel, Inc.*, 314 F.3d 1313, 1335; 65 USPQ2d 1385 (Fed. Cir. 2003). Here, the mixture processes and expandability differences are immaterial to patentability. The material limitations are those which describe the article produced, e.g., fibrils, nodes, pores.

Further, the law is clear that the “specification need teach only one mode of making and using a claimed composition.” *Id.* This requirement is met by the original disclosure. The original disclosures include production processes which provide the PTFE materials used (*i.e.*, Dalton measurements, mixing ratios) to the extent that an artisan with the knowledge of one skilled in the art would be able to recreate the invention. Thus, the Examiner’s suggestions that one skilled in the art would be subjected to undue experimentation are without merit because the precise details are disclosed. Thus, the legal requirements have been met. It should be noted, however, that amendments have been made to clarify the issues.

In addition to the written description and enablement rejections, the Examiner also makes *Slob* based indefiniteness rejections. As discussed above, *Slob* does not apply to the claims in this application which are proper product by process claims. The present claims (unlike in *Slob*) very definitely set forth the product articles structure including fibril, node, and

pore arrangements. The article recitations are not set out in a way in which they only describe desired characteristics. Therefore, we believe the indefinite rejections should also be withdrawn.

The Examiner has asserted numerous art-based rejections based on U.S. Patent No. 6,039,755 issued to Edwin et al. Nothing like the repeated arrangement seen in FIGs. 2 and 4 of the present invention can be found in any of the micrographs included in Edwin. Edwin's processes (see Cols. 9 and 10) are completely different than those disclosed in the present invention (see the specification). In fact, Edwin uses only one PTFE resin at a time. It is, of course, fundamental to the creation of the article claimed that two resins be used.

Review of Edwin also reveals resulting structures are starkly different. See, e.g., the illustration of FIG. 2 and all of the micrographs referenced by the examiner. All of these images show articles having uniform internodal distances between elongated nodes. Even beyond that, this uniformity is the chief objective of the patent. See Col. 10 lines 10-30 and claims 1 and 14. There is no mention of distinct groups of pores. Any deviations in Edwin's micrographs which stray from uniform internodal distances are an aberration contrary to the goals of the patent. See Col. 10 lines 10-30.

The Examiner suggests that FIGs. 18D, 21B, and 21D show the node/fibril/pore arrangement of the present invention. These figures, however, simply do not show a repeated structure-within-a-structure arrangement like that claimed. Much less any consistent pattern of discretely-sized pores. The Edwin pores are instead, radically orientated.

Because the Examiner has failed to show all the claimed limitations it is respectfully suggested that the Examiner's rejections should be withdrawn, and this application passed on to issue. Applicant does not believe that any fee is due with this amendment. However, if Applicant is mistaken, the Commissioner is authorized to deduct any required fee

from Deposit Account 19-2112. If the Examiner has any questions concerning this case, he is encouraged to contact the undersigned at the number below.

Respectfully submitted,

A handwritten signature in dark ink, appearing to read 'M. Honeyman', with a long, sweeping horizontal flourish extending to the right.

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MSH/tjd

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